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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,330	02/06/2004	Gregory R. Furnish	GSP0034C3	8531

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EXAMINER
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MAI, HAO D

ART UNIT	PAPER NUMBER
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3732

MAIL DATE	DELIVERY MODE
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10/17/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/774,330

Applicant(s) *mn*

FURNISH ET AL.

Examiner

Hao D. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 27-49 is/are pending in the application.
- 4a) Of the above claim(s) 37-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-36 and 45-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of **Species I** in the reply filed on 9/19/2007 is acknowledged. The traversal is on the ground(s) that the similarity of subject matter being claimed put no serious burden on the Examiner. This is not found persuasive because:
  - a. The applicants disclosed Figures 5, 6, and 7 to be alternative embodiments (Specification, page 5), rendering the embodiments to be patentably distinct species each of which would require a separate search; and
  - b. The claimed species are mutually exclusive, which would require separate searches. MPEP § 806.04(f). Claims 25-49, drawn to multiple species, are mutually exclusive because claim 37 recites limitation "a bowl-shaped member" which is drawn to species II but not species I, and III.

The requirement is thus still deemed proper and is therefore made FINAL.

2. This application currently contains **claims 37-44** drawn to a species nonelected with traverse in the reply filed on 9/19/2007. Accordingly, claims 37-44 are withdrawn from consideration and have not been treated on merits in this Action. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### *Specification*

3. The history of continuations or continuation-in-parts for this application is incomplete. Appropriate correction is required.

***Double Patenting***

**4. Claim 48 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 (parts a, b, and c) of prior U.S. Patent No. 6254535 B1. This is a non-statutory double patenting rejection.**

The difference between the application claims 48 and the patent claim 1 lies in the fact that the patent claims include more elements and are thus much specific. Thus the invention of the patent claims are in effect a "species" of the "generic" invention of the application claims. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claims are anticipated by the patent claims, they are not patentably distinct from the patent claims.

***Claim Rejections - 35 USC § 102***

**5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**6. Claims 27-33, and 48, are rejected under 35 U.S.C. 102(b) as being anticipated by Barish et al. (3240516).**

**Regarding claims 27-28, and 48,** Barish et al. disclose a joint structure of a retractor comprising: a bifurcated member 22 having two elongated prongs 24; an elongated handle segment 10; and ball joint 14 providing means for rotatably and pivotally connecting the handle segment 10 to the bifurcated member 24, allowing the bifurcated member to rotate and pivot relative to the handle segment (Fig. 1-2; column 2 lines 34-37).

The connecting means of ball joint 14 is disclosed to comprise: a longitudinally-extending bore within the handle 10 as the handle is hollow (column 1 line 68); a ball 72 disposed within said bore (Fig. 1-2).

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**Regarding claims 29-30**, Barish et al. disclose a locking means for locking the connecting means so that the ball and its attached bifurcated member is held in one position. The locking means comprises: a rod/shaft 40 that is complementarily received within the hollow/bore of the handle; a socket 74 attached to the lower end of the rod 40, the socket having a spherical surface adapted to mate with the ball; and a means for adjustable positioning the rod so that as the rod is forced outwardly the ball 72 will be clamped between the end/socket 74 of the rod 40 and the inturned end 70 of the ball retainer 68 (Fig. 1-2; column 2 lines 34-52).

**Regarding claims 31-33**, rod 40 is shown to complementarily engage the bore/hollow of the handle 10 via a joint mechanism shown in Fig. 3 (column 1 line 67 – column 2 line 26). Furthermore, a tightener is disclosed comprising locking member 62 and handle 64 (Fig. 1, 3). The tightener is disposed outside of the bore, and rotates to exert pressure on the rod 40.

### *Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 34-36, 47, and 49, are rejected under 35 U.S.C. 103(a) as being unpatentable over Barish et al. (3240516) in view of Biegler (2674501).**

Barish et al. disclose a ball and socket joint for a retractor according to claims 27-28, and 48 (see rejection above). However, Barish et al. fail to disclose a means for removably mounting the bifurcated member 24 to the handle 10.

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Biegler discloses a handle connection for a garden hoes that has a ball structure as Barish et al.'s bifurcated member. Biegler teaches of a means for removably mounting the ball 18 to handle 14 at the expansible socket 22. The expansible socket is a portion of the handle and defines an opening therethrough for allowing the ball to traverse therethrough between occupied and withdrawn positions (Fig. 1; column 1 lines 48-62).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute Barish et al.'s ball retainer 70 with Biegler's expansible socket 22 so that the connecting ball may be removably mounted as explicitly taught by Biegler.

**9. Claims 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barish et al. (3240516) in view of Wilson, Jr. et al. (5133724).**

Barish et al. disclose a ball and socket joint for a retractor according to claims 27 (see rejection above). However, Barish et al. fail to disclose the prong of the bifurcated member having a textured surface being a DeBakey serrated pattern.

It is well known in the art of retractor and stabilizer for the retractor's or stabilizer's blade(s) to have a textured surface for better engagement with the tissue being retracted or stabilized. Additionally, Wilson Jr. et al. suggest that the DeBakey serrated pattern is well known to be used for textured surface is aortic clamps (column 1 line 23-26). Official notice is taken that it would have been obvious to one having ordinary skill in the art to make the Barish et al.'s bifurcated member with prongs having a textured surface being a DeBakey serrated pattern for better engagement with the tissue being retracted or stabilized.

### *Conclusion*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hao D. Mai whose telephone number is (571) 270-3002. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HDM 10/12/2007

/Cary E. O'Connor/

Primary Examiner

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